REMARKS:

Claims 1-17 are present for examination.

The Examiner has indicated that claims 4 and 12 are objected to but contain allowable subject matter. By way of the instant amendment, claims 4 and 12 have been placed in independent form and incorporate therein the limitations of the claims from which they depend. Thus, claims 4 and 12 are deemed to be allowable.

Claims 1-3, 5, 7 and 8 stand rejected under 35 U.S.C. § 103 as unpatentable over Bowers in view of Takagi. The Examiner recognizes that Bowers does not teach a battery accommodating portion for the input apparatus and points to Takagi teaching a battery accommodating portion 15 for accommodating a battery used to supply power to the information processing device 1 when the input apparatus 23a is coupled to the predetermined portion of the portable telephone apparatus by the coupling mechanism 18 (Figure 3). The Examiner concludes that it would be obvious to combine the two references.

The Examiner's rejection is respectfully traverse.

If one were to modify the teaching of Bowers by incorporating therein the teaching of Takagi, one would presumably enlarge the pointing device 30 of Bowers so that it is large enough to accommodate batteries sufficient to supply power to the computer when the pointing device is installed in the computer as shown, for example, in Figure 7. This would mean that the pointing device would have to be much bigger than disclosed by Bowers and also much heavier. Moreover, when the pointing device is removed from the computer as shown in Figure 2 and is slide along the surface in order to operate the pointing device and to change the cursor on the display of the computer, the computer must nevertheless have enough power to provide all of the normal operating functions of the computer. Thus, the portable computer 10 must also have yet additional batteries within the main housing of the computer and separate and apart from the batteries which are by assumption contained in the pointing device 30. This must be true if one would want to operate the bold features of the computer with the pointing device detached. Such an arrangement, of course, would make absolutely no sense, and it is very difficult to envision why one of ordinary skill and art would

have batteries in both the pointing device and the computer housing each sufficient to fully run the computer. The trend in portable computers is to make them lighter, not heavier. It is also difficult to imagine why one of ordinary skill in the art would take a light weight, easily detachable and easily movable pointing device of Bowers and replace it with a larger and heavier device containing batteries which are sufficient to supply power to the computer when the pointing device is coupled to the pre-determined portion of the computer.

In this connection, it is pointed out that it appears that Takagi's device simply does not work at all when the battery casing section is detached from the main casing. In other words, there does not appear to be any backup battery at all or any other power source within the main casing 1, so that when the battery casing is removed, the telephone unit 1 is inoperative. Clearly, Bowers does not envision such an operation since when the pointing device of Bowers is removed, it is certainly desired to operate the computer and this is the reason why the batteries of Bowers must be incorporated within the main housing of the computer - so that the computer will work when the pointing device 30 removed or detached.

For the reasons indicated above, a person of ordinary skill in the art would not be motivated to combine the teaching of Bowers and Takagi in order to arrive at applicant's claimed invention. Indeed, nothing within the references themselves would lead one or motivate one to combine the teachings in the manner presented by the Examiner and attempting to do so result in an unreasonable structure duplicating battery requirements for the Bowers computer. Thus, it is submitted that the Patent and Trademark Office has not made out a prima facie case of obviousness under the provisions of 35 U.S.C. § 103 and that the rejection of claims 1-3, 5, 7 and 8 must be withdrawn.

Claims 9-11 and 13-17 stand rejected under 35 U.S.C. § 103 as unpatentable over Bowers and Takagi and further in view of Henderson and Constien.

The Examiner again takes the basic combination of Bowers and Takagi (and inappropriate combination as indicated above) but now combines the teachings of Henderson to show a portable telephone and the teachings of Constien for teaching the coupling of an input device to a handset of the portable telephone apparatus.

The Examiner's rejections are respectfully traversed.

The comments set forth above as to the inappropriateness of combining primary reference of Bowers with the secondary reference of Takagi is incorporated herein by reference.

With regard to combining these teachings with Henderson, it is noted that Henderson does not realize a removable pointing device at all and indeed provides for a mouse module 15 which may be slid along a guide or rails provided on a base tray so that it may accommodate right-hand or left-hand persons. (See Col. 3, lines 46-50 of Henderson.) Further, while Henderson does show a portable telephone integrated in a computer module, the telephone headset itself does not have a detachable mouse which inputs coordinate information into the telephone display and a coupling mechanism for detachably coupling the input device to the handset of the portable telephone apparatus. Indeed, Henderson does not show anything coupled to the handset 14 of the portable telephone apparatus except for the cord 24. Certainly, the mouse 15 does not integrate into the handset and thus it is unclear how Henderson can be combined with the teachings of Bowers and Takagi to arrive at applicant's invention.

The Examiner has also combined Bowers, Takagi and Henderson with Constien, stating that Constien teaches coupling the input device to a handset of the portable apparatus. However, applicant's input device as recited in independent Claim 9 is for inputting coordinate information to the portable telephone apparatus to control a position of a cursor on the display of the portable telephone apparatus wherein the coordinate information varies depending on a movement of the input device on a flat surface. No such corresponding structure is shown in Constien. Constien shows a telephone/ portable computer combination, but there does not appear to be any mouse (pointing device) connected to the portable computer and certainly there is no indication of any mouse which is detachably coupled. Moreover, the power supply 15 shown in Figure 4 of Constien is quite large and occupies nearly half of the area of the telephone as shown in Figure 4. Absent any teaching of a mouse or cursor function for the computer in Constien, Applicant is at a loss as to what motivation may be provided to somehow combine the references as suggested by the Examiner. The

input device of Cortson could be considered either the keypads for the telephone portion of Cortson shown in Figure 1 or perhaps the keyboard shown in Figure 2 associated with the computer. However, the keyboard does not provide an input device for the telephone set so it appears that only the keys 5 or perhaps the microphone 7 could be considered an input device for the telephone. However, Applicant's input device is recited to control the cursor movement of the display which would correspond to the display 4 of Cortson. Cortson does not disclose any mechanism for controlling a cursor on the display 4 whether the mechanism is detachable or not.

In view of the deficiencies of the basic combination of Bowers and Takagi as pointed out in connection with the rejection of Claim 1, and in view of the additional comments set forth above in connection with the additional secondary references of Henderson and Cortson, Applicant submits that there is insufficient motivation to combine the four references in order to arrive at Applicant's invention and that the Examiner has merely found bits and pieces of Applicant's invention in these four references, but that combining them to arrive at Applicant's invention can only be done by hindsight. Indeed, one of ordinary skill in the art would not be motivated by the teachings of these references to combine them such as to arrive at Applicant's invention. As such, the Patent and Trademark Office has not made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103.

The Application is now believed to be in condition for allowance and an early indication of same is earnestly solicited.

Respectfully submitted,

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By _____

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